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In re Application of
VERMA et al.
Application No.: 09/646,479 : DECISION ON
PCT No.: PCT/AU99/00165 :
Int. Filing Date: 16 March 1999 : PETITION UNDER
Priority Date: 16 March 1998 :
Attorney Docket No.: NX-5660 : 37 CFR 1.137(b)
For: PORCINE NUCLEAR TRANSFER :
:

This decision is in response to applicants' "PETITION UNDER 37 C.F.R. 1.137(b) FOR REVIVAL OF AN UNINTENTIONALLY ABANDONED APPLICATION" filed 28 July 2004 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 16 March 1999, applicants filed international application PCT/AU99/00165, which claimed a priority date of 16 March 1998. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 23 September 1999. A Demand for international preliminary examination, in which the United States was elected, was filed on 12 October 1999, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 18 September 2000 (16 September 2000 being a Saturday).

On 15 September 2000, applicants filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*, the basic national fee and the surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty months from the priority date.

On 02 October 2000, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration in compliance with 37 CFR 1.497(a)-(b) was required. The NOTIFICATION set a two-month extendable period for reply.

On 19 December 2001, the USPTO mailed a NOTICE OF ABANDONMENT indicating,

inter alia, that the application was abandoned for failure to timely or properly reply to the NOTIFICATION OF MISSING REQUIREMENTS mailed 02 October 2000.

On 28 July 2004, applicants submitted the instant "PETITION UNDER 37 C.F.R. 1.137(b) FOR REVIVAL OF AN UNINTENTIONALLY ABANDONED APPLICATION" which was accompanied by, *inter alia*, a declaration of inventors.

DISCUSSION

The extendable period for reply to the NOTIFICATION OF MISSING REQUIREMENTS mailed 02 October 2000 expired at midnight on 02 April 2001. Thus, the above-identified application was abandoned as of midnight 02 April 2001.

A petition to revive the present application under 37 CFR 1.137(b) must include:

- (1) The required reply;
- (2) The petition fee;
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional.

As to item (1), applicant submitted a declaration of inventors on 28 July 2004.

As to item (2), applicant submitted the petition fee on 28 July 2004.

As to item (3), the required statement has been provided. The above-identified application has been abandoned for an extended period of time. The USPTO is relying on petitioner's duty of candor and good faith and accepting the statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. See Changes to Patent Practice and Procedure, 62 Fed. Reg. At 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 CFR 10.18 to inquire into the underlying facts and circumstances when providing the statement required by 37 CFR 1.137(b) to the USPTO).

A review of the application file reveals that, with the filing of the present petition and accompanying papers, a proper response has been submitted and all of the requirements of 37 CFR 1.137(b) for revival have been satisfied and revival is therefore appropriate.

The declaration of inventors filed 28 July 2004 is in compliance with 37 CFR 1.497(a)-(b).

CONCLUSION

The petition under 37 CFR 1.137(b) is **GRANTED** for the reasons set forth above.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations to continue national stage processing of the application.



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